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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/277,335 | 03/26/1999 | DEAN A. KLEIN | MPATENT.053A | 3400 |

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EXAMINER

LEE, CHI-CHUNG

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2131

DATE MAILED: 05/08/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/277,335

Applicant(s)

KLEIN, DEAN A.

Examiner

Chi-Chung E Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

a) The reference character "44" have been used to designate the host bus and should not be treated as a data storage device (page 7, line 29).

b) An extra space is need to separate "2" and "and" (page 4, line5).

Appropriate correction is required

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "substantially" in claim 8 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Without such disclosure, one of ordinary skill in the art would not be able to show the association of the information with the host computing logic.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 – 4, 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pond in view of Computer Dictionary. (616)

Claim 1 is directed to a method of storing data in a magnetic or optical storage media.

The method is practiced in a computer comprises steps of retrieving, generating, and encryption.

Pond is directed to a method of storing data in a protected form for retrieval by authorized parties. The method includes use of plurality of IDs, 12, including master ID, machine ID, configuration ID, primary ID, and secondary ID. These IDs are used to generate various keys, 14, which are input to a key stream generator is for generating key streams 16, 20, 22, 24, and 26. (see Col. 5 lines 44-59; Col. 3 lines 19-23). These key streams are used to encrypt plain text and decrypt encoded text. (see Col. 5 lines 60-61). Column 6 lines 35-54 disclose that data encrypted with the key streams becomes a protected file. The examiner asserts that this disclosure clearly suggests use of storage means for storing the protected file.

Pond differs from the claimed invention in that it fails to disclose use of magnetic or optical storage for encrypted data of nonvolatile memory for storing the ID code.

As disclosed in Computer Dictionary, use of nonvolatile memory was known prior to applicant's filing date. Motivation to use nonvolatile memory to store the master ID, machine ID, configuration ID, primary ID, and secondary ID would have been the ability to prevent loss of IDs during power failure. In addition, the computer Dictionary discloses use of a magnets-optical disc was known prior to applicant's filing date. Motivation to use a magnets-optical disc to store the protected data would have been the ability to update the data.

7. As per claim 2, Pond is directed to retrieve the ID key stream (i.e. information) corresponding to each of the identifiers from the label (i.e. memory) for decrypting the file (see col. 9 lines 64-67; col. 3 19-62). Claim 2 is directed to retrieve information from memory, decrypt the data response to the information and store it to one of the data storage.

8. As per claim 3, Pond is directed to a method of defining the relationship between the IDs, keys, and key streams. For each ID, a corresponding random-like number, called key, is generated and utilized to seed a key stream generator to generate a key stream (see col. 5 lines 44-59; Figure 1).

9. As per claim 4. Pond is directed the method of using ciphering processor to decrypt the file label that comprise a key mix. The checksum process is then used to verify that the key mix of the label has not been tampered with (col. 4 line 21 – 36; Figure 4). Finally, the examiner avers that use of distributed processing in compute rrelated arts is well known. As discuss in Computer Dictionary, use of distributes processing was known prior to applicant's file date. Motivation to use a distributed processing is to share workload in the computer system. Claim 3 –4 are rejected.

10. Claim 7 is rejected on the same bases as claim 1

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11. As per claim 8, Pond discloses use of an machine Id as part of the key to generate a key stream, see Figure 1. Claim 8 is rejected.
12. As per claim 9, the examiner asserts that if multiple bits are needed to store the number, then it would be obvious to make use of the necessary number of bits. Claim 9 is rejected.
13. As per claim 10, see figure 1. Claim 10 is rejected.
14. As per claim 11, use of nonvolatile memory was address in the rejection of claim 1. Claim 11 is rejected.
15. As per claim 12, see col. 5 lines 1- 45. Claim 12 is rejected.
16. Claim 5 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pond in view of Computer Dictionary as applied claim 1 above and further in view of Nishino. Nichino is directed to a method of using a secret number (i.e. hardware ID) stored on a memory card of a IC card (i.e. memory integrated circuit). This ID is employed as a key and is used for the encoding. Thus use of IC card (non-volatile memory integration circuit) to store key related data is well known. The examiner asserts that it would have been obvious to store the ID's used to generates the key stream data would have been to keep this data in a secure and readily available location. Claim 5 is rejected.
17. As per claim 6 use of a serial data bus is well known and the examiner takes official notice of such motivation to use a serial data bus to connect the card reader to the encryption modules of the Pond-Nichono combination would have been to provide a reliable effective method of transmit input data the site of processing. Claim 6 is rejected

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

| | |
|---------------|--------------|
| Larsson et al | 5,379,344 |
| Davis | 5,796,840 |
| Akiyama et al | 5,680,453 |
| Rallis et al | 6,216,230,B1 |
| Davis | 6,185,546 B1 |
| Hoppe | 5,068,894 |
| Davies | 4,799,258 |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chi-Chung E Lee whose telephone number is 703-306-4153. The examiner can normally be reached on 8 am - 5:30 pm, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail O Hayes can be reached on 703-305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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A handwritten signature in black ink, appearing to read "Gail Hayes". The signature is fluid and cursive, with the first name "Gail" written in a larger, more prominent script than the last name "Hayes".

GAIL HAYES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100